



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/883,585	06/27/97	LANGHANS R	59-118-3

QM11/0301  
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EXAMINER
GOODMAN, C

ART UNIT	PAPER NUMBER
3724	16

DATE MAILED: 03/01/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/883,685**

Applicant(s)

**Rene LANGHANS**

Examiner  
**Charles Goodman**

Group Art Unit  
**3724**



☒ Responsive to communication(s) filed on Nov 20, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-3, 5-8, 10-12, and 14-21 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-3, 5-8, 10-12, and 14-21 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 14

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

1. The Preliminary Amendment filed November 20, 1997 has been entered.

### *Priority*

2. Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.
3. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. 08/182,074 under 35 U.S.C. 119(a)-(d), a claim for such foreign priority must be made in this application. In making such claim, applicant may simply identify the application containing the priority papers. In addition, it is noted that the Declaration lists the foreign applications, yet priority has not been positively claimed.

### *Specification*

4. The disclosure is objected to because of the following informalities:
  - i) Again, it is suggested that the advantages in pgs. 3-4 be listed in better form without a mix of incomplete sentences and explanatory sentences.
  - ii) Pg. 5, line 24, the phrase "...subtending an acute angle  $\alpha$  of about 10°" is not clearly understood. Where is this angle in the drawings?

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Appropriate correction is required.

***Drawings***

5. The drawings are objected to because references "26" and "27" should be interchanged to maintain consistency with the depiction in Fig. 1. Correction is required.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "∞" (pg. 5, line 24).  
Correction is required.

7. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "means for releasably coupling" (claim 1, first occurrence) must be shown or the feature canceled from the claim. No new matter should be entered.

8. It is noted that Applicant contends that a proposed drawing correction had been submitted with the Preliminary Amendment. However, this is not included in the file.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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10. Claims 18-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 18 sets forth a means for releasably coupling each cutter unit to a driving unit having a motor whereby each said cutter unit can be driven from said driving unit independently of each other cutting unit, yet the specification as originally filed does not support this limitation. Nowhere does the specification elude to cutter units that are independently driven by a single driving unit.

11. Claims 1-3, 5-8, 10-12, and 14-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Pg. 6, lines 24-33, the phrase "Preferably, the drive unit is a non-positive drive...to be facilitated" is not clearly understood. What is encompassed by the phrase "non-positive drive"? What is it referring to? It is not clear how the drive unit 30 is non-positive when it appears that the drive unit positively engages the drive gears of each respective cutter units via drive shaft 16 to positively drive each pair of cutting blades. In addition, how is the drive unit "detachable"? What structural features facilitates detachment of the drive unit, and where is this detachment feature shown in the drawings? Applicant's explanation on this issue is noted. However,

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Applicant misses the mark. The Examiner acknowledges that Applicant considers “non-positive” drive as the indirect, frictional engagement of the blade shafts. However, this is not germane with respect to the power drive unit of which the specification at page 6 is referring to.

Pg. 7, lines 11-21, the description of how the bush is displaced is confusing. Lines 14-15 state that the pin wrench 25 is used to rotate the bush 13, yet it is not clear how this is accomplished. Where is the slot that the pin wrench fits through shown in the drawings other than Fig. 4? If the slot is the slotted upper protuberance (shown in Fig. 1), then it is not clear how that slot would facilitate rotation of the bush. Applicant’s explanation on this issue is noted. However, the specification does not state anywhere that the “slot” is the so called “circumaxial slot” as Applicant contends. Moreover, Applicant’s explanation still fails to address how the action of the pin wrench facilitates the adjustment as described. Clarification is requested.

Pg. 7, line 29 to pg. 8, line 14, the description of the comparison between the prior art and the state of the art is not clearly understood. What do the percentages represent? How are the parameters defined and by what standard, especially the cutting angle? What is the relevance of the data? Applicant’s explanation on this issue is noted. However, it fails to address the basis of the comparison. The chart does not specify what “prior art” device (or devices) that the invention is compared to, nor does it provide sufficient details as to how these numbers are generated, i.e. what parameters were used to generate this data. Lacking these details, the significance of the comparison is questionable. Moreover, it appears that the comparison, at most, merely shows the inherent results of a cutting unit that is smaller in size than a hypothetical prior art device.

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12. Claims 1-3, 5-8, 10-12, and 14-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with vague and indefinite language and lack of antecedent basis for claimed features. The following are some noted examples. Applicant is advised to thoroughly review all the claims and correct all instances of non-conforming language. Failure to do so will result in the next Office action being made FINAL.

- i) The following phrases lack clear antecedent basis: (claim 1, lines 4 and 13) “the plane of the flat material” and “the upper and lower legs” (the same applies to the rest of the claims referring to any one of the “legs”); and (claim 10) “the nib.”
- ii) In claim 1, lines 9-11, the “non-positive drive connection” clause is not clearly understood. What is the phrase referring to, especially the phrase “...between said blade including a transport ring...with the other of the blade shafts”? The same applies to the rest of the claims. In lines 20-21, the “means for releasably coupling” clause is vague and indefinite in that it is not clear what the phrase encompasses. What is the particular “means” referring to? What structural features are encompassed by this “means”? The same applies to the rest of the claims, especially claim 21 and the phrase “means for non-positively connecting...unit.”
- iii) Claim 6 is vague and indefinite in that it is not clear what the claim encompasses. What is the scope of the claim such that a “circular cutter unit”, which is assumed

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and implied to be referring to a specific part of a broader cutting apparatus, further comprises at least one guide rail? As best understood of the specification, it would seem that, at most, the "circular cutter unit" would comprise a means to allow displacement of the frame as opposed to the "means" as claimed herein.

- iv) Claim 7 is vague and indefinite in that it is not clear what the claim encompasses. What is the scope of this claim? Is this not part of the "means for rotatably supporting" set forth in claim 1, at least according to the specification?
- v) Claim 10 is not clearly understood. What is the "cutting angle" referring to? How is the "angle" defined by an "overlap"?
- vi) In claim 18, the "means for releasably coupling" is vague and indefinite in that it is not clear what the "means" encompasses. What structural features is the phrase referring to, and where is the support for driving of a cutting unit independent of each other cutting unit?

### ***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.



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14. As best understood, claims 1-3, 5-8, 10-12, and 14-21 are rejected under 35

U.S.C. 102(b) as being anticipated by Suzuki et al.

Suzuki et al discloses a gang slitting machine comprising a plurality of cutter units 15A, 15B; each unit having upper and lower circular blades 17, 19; upper and lower blade shafts 131, 163; a non-positive drive connection between the shafts including a transport ring 143, 173 wherein the drive connection is frictional; a frame 25A, 25B, 27, 29, 31A, 31B, 33A, 33B having a U-shape; upper leg 25A, 25B; lower leg 27; a flat yoke 37A, 37B, 39A, 39B disposed at an acute angle; means 133, 135, 165, 167 for rotatably supporting the blade shafts; means for establishing and adjusting a cutting gap between the circular blades (col. 9, lines 24-31) within the range as claimed; an inherent means for releasably coupling one of the circular blade to a driving unit having a motor 299 since the connection thereof is inherently detachable; means for displaceably mounting the frame including at least one guide rail 81; a cutting angle within the range as claimed since the blades are overlapping within the range as claimed; each of the shafts have a diameter within the range as claimed since they are relatively small as depicted in the Figures; it appears that the yoke have the acute angle within the range as claimed (see Fig. 4); means 77 on each frame slidably engaging the guide rails; and means 129, 161 for transmitting drive motion provided by the driving unit. See whole document.

Regarding claim 18, the phrase "whereby each said cutter unit can be driven..." has not been given significant patentable weight, since it has been held that the functional "whereby"

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statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

### ***Response to Arguments***

15. Applicant's arguments with respect to claims 1-3, 5-8, 10-12, and 14-21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

16. Cox et al is cited as additional pertinent art.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet

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communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

CG   
February 24, 1999

  
**M. Rachuba**  
Primary Examiner